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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

COLBERT, ELLA

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/731,359	JEBENS ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 104-112 and 121-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 104-112 and 121-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>28 December 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 104-112 and 121-126 are pending. Claims 104, 111, 121, 123, 125, and 126 have been amended in this communication filed 12/28/04 entered as Response to Non-Final Rejection.
2. The IDS filed 12/28/04 has been considered.
3. The Request for Extension of Time has been Granted and entered.
4. The 35 USC 112 Second Rejection for claims 108, 111, 112, 121, 122, 123, 125 and 126 has been overcome by Applicants' amendment to the claims and is hereby withdrawn. The 35 USC 112 Second Rejection for claims 104, 121, and 125 still remains as set forth here below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 104, 121, and 125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 104, 121, and 125 are vague, confusing and unclear. Claim 104 begins with "an electronic storage facility ... that are not authorized users identified by the first image provider;". Claims 121 and 125 have a similar problem.

Claim 121, line 9 recites "authorized users identified by the first image provider". Do Applicants' mean "an authorized user identified by the first image provider ..."?

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 104-112 and 121-126 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,666,215) Fredlund et al, hereafter Fredlund in view of (US 5,153,936) Morris et al, hereafter Morris.

With respect to claims 104 and 121, Fredlund teaches, an electronic storage facility (col. 2, lines 28-31 and col. 3, lines 32-36) for providing storage for high resolution digital images (col. 3, lines 63-67) of a plurality of unrelated image providers, at least some of the high resolution digital images stored in the electronic storage facility (col. 4, lines 10-66) being used to develop corresponding low resolution copies, each of the high resolution digital images having a higher bandwidth communication requirement than each of the corresponding low resolution copies, the electronic storage facility storing the high resolution digital images of a first one of the image providers such that the high resolution digital images of the first image provider and such that the high resolution digital images of the first image provider are can only be accessed by authorized users identified by the first image and such that the high resolution digital images of the first image provider are transparent to other unrelated image providers that are not authorized users identified by the first image provider (col. 6, lines 10-33 and fig. 2(34 & 38); means for allowing the authorized user to download the low resolution copy corresponding to one of the high resolution digital images of the first image provider from the electronic storage facility to a first location (col. 6, lines 50-63, col. 8, lines 16-27, and fig. 6 (112 & 118); and means for electronically routing the

high resolution digital image to a printer in response to a request from the authorized user (col. 8, lines 45-61).

Fredlund did not teach, means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user.

Morris disclosed, means for notifying an authorized user identified by the first image provider that the authorized user has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user (col. 1, lines 63-67 and col. 2, lines 1-4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have means for notifying an authorized user identified by the first image provider that the authorization has been authorized to download a low resolution copy corresponding to one of the high resolution digital images, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user and to modify in Fredlund because such a modification would allow Fredlund to have a message as an identification of the user and/or identification of the digital image to which the third party has been granted access with the images including downloading a low resolution copy of the high resolution image with the message including an electronic address (URL designation for a World Wide Web site on the Internet).

With respect to claim 105, Fredlund teaches, further comprising means for processing the high resolution digital images to develop the corresponding low

resolution copies (bonus prints) (col. 3, lines 64-67, col. 6, lines 23-29, and col. 8, lines 45-51).

With respect to claim 106, Fredlund did not teach, further comprising a mail database, the mail database including a conventional address for the authorized user, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a mail database, the mail database including a conventional address for the authorized user and to modify in Fredlund because such a modification would allow Fredlund to have a place to store the collected mail. A database by definition is a collection of data stored on a computer storage medium, such as a disk, that can be used for more than one purpose.

With respect to claim 107, Fredlund and Morris did not teach, further comprising a search engine for searching among digital images stored in the storage device, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a search engine for searching among digital images stored in the storage device and to modify in Fredlund because such a modification would allow Fredlund to have a computer program that searches through large amounts of text or other data which is well known in the art.

With respect to claim 108, Fredlund teaches, a storage device (col. 4, lines 34-36) and a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet (col. 2, lines 28-30 and lines 33-42 and col. 5, lines 20-31). Fredlund and Morris did not teach, a mail server and a router but it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fredlund to include a mail server and a router to perform the steps of claim 108 in view of Fredlund's modem and interactive cable TV network and because a mail

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server would allow Fredlund to have the ability to provide mail services to another computer (called a client) and to connect to two or more networks.

This independent claim is rejected for the similar rationale given above for claim 104.

With respect to claim 109, Fredlund did not teach, wherein the digital images are input to the system by the first image provider via a communication device.

Morris disclosed, wherein the digital images are input to the system by the first image provider via a communication device (col. 3, lines 44-67 and col. 4, lines 1-8). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the digital images input into the system by the first image provider via a communication device and to modify in Fredlund because such a modification would allow Fredlund to communications means (such as one or more modems or communications cards) and one or more digital processors for loading the digital images into the system.

With respect to claim 110, Fredlund teaches, an image handler (col. 2, lines 28-34 and lines 42-44) for processing the digital images input by the first image provider, the image handler being adapted to develop low resolution images of the digital images received from the first image provider and to store both the digital images received from the first image provider and the low resolution images thereof in the storage device in an addressable fashion for future searching (col. 4, lines 34-36 and lines 46-50).

With respect to claims 111 & 126, Fredlund teaches, storing a high resolution and a low resolution copy of a digital image provided by a first image provider in an electronically searchable format on a storage device (col. 4, lines 19-21).

These independent claims are rejected for the similar rationale given above for claim 108.

With respect to claim 112, Fredlund teaches, a storage device for storing digital images received from a first digital image provider and a second digital image provider (col. 3, lines 32-36).

Fredlund and Morris did not teach, a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user and a user identifier for discriminating between users communicating with system to control user access to the digital images stored in the storage device, the user identifier limiting access to the digital images provided by the first digital image provider to at least one user identified by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a job order developer responsive to inputs received from the first user for developing a job order that includes at least one high resolution copy of a digital image contained in the subset and identified by the first user and a user identifier for discriminating between users communicating with system to control user access to the digital images stored in the storage device, the user identifier limiting access to the digital images provided by the first digital image provider to at least one user identified by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider and to modify in Fredlund because such a modification would allow Fredlund to have a high resolution copy of the digital image which can be transmitted by an automatic e-mail notification to the third parties which have been granted access rights.

This independent claim has also rejected for the similar rationale given above for claims 106-108.

With respect to claim 122, this independent claim is also rejected for the similar rationale given above for claim 112.

With respect to claim 123, this independent claim is rejected for the similar rationale given above for claims 104-112 and 121-122.

With respect to claim 124, this independent claim is rejected for the similar rationale given above for claims 108 and 112.

With respect to claim 125, this independent claim is rejected for the similar rationale given above for claims 104 and 121.

Response to Arguments

9. Applicants' arguments filed 12/28/04 have been fully considered but they are not persuasive. Accordingly, below are the issues that the Examiner considered to be the main issues.

Issue no. 1: Applicants' argue: Fredlund fails to teach or suggest the capability to identify additional authorized users and likewise Morris does not disclose a sharing system in which the image provider may identify additional authorized users has been considered but is not persuasive. Response: In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the capability to identify additional authorized users and a sharing system in which the image provider may identify additional authorized users") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are

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not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is not interpreted that Applicants' claim limitations suggest or disclose "the capability to identify additional authorized users and a sharing system in which the image provider may identify additional authorized users" as argued by the Applicants'.

Issue no. 2: Applicants' argue: Morris clearly does not disclose or suggest any kind of notification to authorized users and it follows that Morris does not disclose or suggest that users are authorized for access to digital images, of either high or low resolution. Even if Morris supplied the elements missing in Fredlund, there is not any suggestion to combine the references and the Examiner's stated motivation to combine, found on page 5, relies on elements that are in neither of the references, i. e. third party access, downloading messages with images, and electronic addresses (Internet URLs) suggesting perhaps a reliance on unacceptable hindsight has been considered but is not persuasive. Response: In response to Applicants' arguments that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Fredlund was not used to reject this claim limitation as far as the Examiner can determine. It is interpreted that Morris teaches authorized users that are identified by the first image provider and a pathname to the at least one user identified by the digital

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image provider in col. 1, lines 63-67 and col. 2, lines 1-4. The pathname is interpreted as an electronic address (Internet URLs). Digital images are found in downloaded messages or at least they are found in some of the messages I receive via the Internet and e-mail.

Issue no. 3: Applicants' argue: There is no teaching or suggestion in Fredlund of the image provider authorizing users. Response: It is interpreted that Fredlund teaches, image providers authorizing users in col. 6, lines 30-38 ("... the order for a particular image is completed, ... The image is sent to different addresses (image providers) on the screen ...").

Issue no. 4: Applicants' argue: There has not been a prima facie case of obviousness established, there must be actual evidence of a suggestion to modify a prior art reference to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular has been considered but is not persuasive. Response: See MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of

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obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Conclusion: The Examiner carefully drew up a correspondence of each of Applicants' claimed limitations, one or more referenced passages in Fredlund and Morris, what is well known in the art and what is obvious to one having ordinary skill in the art at the time the invention was made.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

It is respectfully requested Applicant point out to the Examiner the inventive concept in the claim limitations of claims 1,6, and 15 and to particularly and distinctly claim that which the Applicant claims to be the inventive concept in the claim language.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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E. Colbert

April 2, 2005